

REMARKS

Claims 13 - 16 remain active in this application. New claims 17 - 19 have been added to more fully recite the subject matter regarded as the invention. Support for new claim 17 - 19 is found on pages 8, 13 and 16 and Figures 2e and 2i. Claims 1 - 12 have previously been canceled. No new matter has been introduced into the application.

Claims 13 - 16 have been rejected under 35 U.S.C. §103 as being unpatentable over Chantre et al. in view of Racanelli et al. and the admitted prior art. This ground of rejection is respectfully traversed for the reasons set out in the response filed September 3, 2003, which is hereby fully incorporated herein by reference. In particular, it is respectfully submitted that Racanelli et al. is not prior art as to the present invention as has been amply demonstrated by the declarations of the available inventors under 37 C.F.R. §1.131 previously submitted. By the same token, it is respectfully submitted that the subject matter of Racanelli et al. cannot be prior art, admitted (e.g. from citation in an Information Disclosure Statement) or otherwise, as to the present invention contrary to the facts of the matter as demonstrated in the declarations. Further, it is clear that neither Chantre et al. or the admitted prior art teach or suggest any technique for forming the emitter stack without spacers *and in combination with* the particular alignment of the extrinsic base regions and it is not clear that Racanelli et al., even if competent prior art, supplements Chantre et al. and the admitted prior art in this regard or that such a modification of either to answer the claim recitations would not prevent formation and operation of Chantre et al. and/or the admitted prior art in the manner intended. See *In re Gordon*, 221 USPQ 1125 (Fed. Circ, 1984).

The Examiner's statement of the rejection does not *inter alia*, address this explicit recitation of features *in combination* as set forth in claim 13 and, for that reason, does not make a *prima facie* demonstration of obviousness of any claim in the application. Further, in regard to forming the emitter stack without sidewalls and with the recited alignment, the Examiner makes only a general reference to the "prior art of record" in regard to the provision of a "mask cap" and it is thus unclear what prior art the Examiner may be relying upon in this regard and certainly falling far short of demonstrating obviousness by a clear and convincing line of reasoning. It is well-established that the Examiner must consider everything Applicant has said concerning the admitted prior art in order to ascertain the scope of any admission (see *In re Nomiya*, 168 USPQ 607 (CCPA, 1975)) and failure to adequately identify what is considered to be admitted prior art in the statement of the rejection precludes a *prima facie* demonstration of obviousness from being made. Therefore, the stated ground of rejection, as it stands, is untenable in the absence of a *prima facie* demonstration of its propriety and properly identifying the evidence of the level of ordinary skill in the art relied upon.

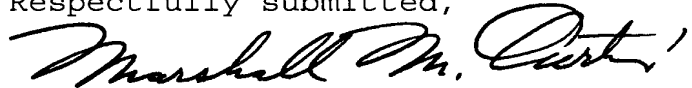
Accordingly, it is respectfully submitted that the stated ground of rejection is in error and, upon reconsideration, should be withdrawn. The statement of the rejection is improper and inadequate to make a *prima facie* demonstration of obviousness of any claim in the application upon a proper evidentiary basis, does not establish the proper combination of teachings from the references applied and, further, relies on teachings which may not be competent prior art either through the Examiner's failure to adequately identify the source thereof and/or the prior invention by the inventors herein. Therefore, reconsideration and

withdrawal of the ground of rejection or record is respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0458 of International Business Machines Corporation (E. Fishkill).

Respectfully submitted,



Marshall M. Curtis
Reg. No. 33,138

Whitham, Curtis & Christofferson, P. C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190

Customer Number: 30743
(703) 787-9400